IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

(Attorney Docket No. 03-380-D)

In re application of:	)	
	)	
Rosenberg et al.	)	
	)	
Serial No.: 09/978,170	)	Examiner: Bennett M. Sigmond
	)	
Filed: October 15, 2001	)	
	)	
Confirmation No.: 3931	)	Group Art Unit: 3688
	)	
For: Method and System for Pause Ads	)	

APPEAL BRIEF

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Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

APPEAL BRIEF

Dear Sir:

This Appeal Brief is submitted pursuant to 37 C.F.R. § 41.37, within three months of February 8, 2011, the mailing date of an office action including final rejections that are being appealed. The Patent Office is authorized to charge the required fees to Deposit Account 132490 and is generally authorized to charge any underpayment or credit any overpayment in this matter to the same deposit account. The Patent Office is further authorized to treat any communication submitted for this application that requires an extension of time as incorporating a request for such an extension.

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I. Real party in interest

The real party in interest is The DIRECTV Group, Inc. to which the claimed invention is assigned.

II. Related appeals and interferences

This appeal brief is for U.S. Patent Application No. 09/978,170. U.S. Patent Application No. 09/978,170 and U.S. Patent Application No. 09/978,144 each claim priority to U.S. provisional Patent Application Nos. 60/240,714 and 60/240,715. U.S. Patent Application No. 09/978,144 remains under appeal before the Board of Patent Appeals and Interferences of the U.S. Patent and Trademark Office. U.S. Patent Application No. 10/033,401 is a continuation application of U.S. Patent Application No. 09/978,144 and remains under appeal before the Board of Patent Appeals and Interferences of the U.S. Patent and Trademark Office.

III. Status of claims

Claims 1, 2, 5-11, 13-15, 17, 18, 22-28, and 31 are currently pending and have been rejected under 35 U.S.C. § 103(a). The rejections of claims 1, 2, 5-11, 13-15, 17, 18, 22-28, and 31 are being appealed. Claims 3, 4, 12, 16, 19-21, 29, and 30 have been canceled.

IV. Status of amendments

Pursuant to 37 C.F.R. § 41.33, Appellants submit herewith a paper to cancel claims 29 and 30. No other amendments have occurred since the office action was mailed on February 8, 2011.

V. Summary of claimed subject matter

Claim 1, the only pending independent claim, is directed to a method of displaying an ad on a video replay system.

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Claim 1 recites a method of displaying an ad on a video replay system (*see*, specification, page 3, lines 11-13 and lines 22-24), the method comprising: obtaining a first ad (*Id.* at page 21, lines 18-21), displaying, on a display of the video replay system (*Id.* at Figure 1(a) (106), and Figure 2 (106, 200)), user selected program content stored at a storage medium of the video replay system (*Id.* at page 3, lines 24-29), while the user selected program content is being displayed on the display of the video replay system (*Id.* at page 3, lines 24-29), entering a pause mode in response to a user action that comprises pressing a pause key (*Id.* at page 21, lines 15-16), upon entering the pause mode, the video replay system starting a timer and subsequently using the timer to determine whether a time delay greater than zero seconds has elapsed (*Id.* at page 21, lines 15-19, and Figure 10 (1002, 1004, 1006, 1008)), after starting the timer but prior to the video replay system determining that the time delay has elapsed, continuing to display the user selected program content on the display of the video replay system, wherein the user selected program content displayed during the time delay is paused (*Id.* at page 20, lines 10-12, 19-24, and 28-29, and page 21, lines 15-19, and Figure 10 (1002, 1004, 1006, 1008)), and after the video replay system determines that the time delay has elapsed, displaying, on the display of the video replay system, the first ad instead of the user selected program content (*Id.* at page 20, lines 10-12, 19-24, and 28-29, and page 21, lines 15-19 and 23-25, and Figure 10 (1002, 1004, 1006, 1008, 1010)).

VI. Grounds of rejection to be reviewed on appeal

a. Independent claim 1 stands rejected as being allegedly obvious over U.S. Patent Application Publication No. 2003/0037068 (Thomas), in view of U.S. Patent No. 7,017,173 (Armstrong) and U.S. Patent No. 5,543,743 (Cooper).

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b. Dependent claims 2, 5-11, 13-15, 17, 18, 22, 24, 26, 27, and 31 stand rejected as being allegedly obvious over Thomas in view of Armstrong and Cooper.

c. Dependent claim 23 stands rejected as being allegedly obvious over Thomas in view of Armstrong, Cooper, and U.S. Patent No. 7,225,142 (Apte).

d. Dependent claims 25 and 28 stand rejected as being allegedly obvious over Thomas in view of Armstrong, Cooper, and U.S. Patent No. 6,632,127 (Bandera).

VII. Argument

a. Thomas

The Examiner relied on Thomas for the rejection of each pending claim. The Examiner stated that Thomas claims domestic priority to provisional application no. 60/193,894 filed on March 30, 2000. The Examiner further stated that a reference to "Thomas" shall include the claim of priority to the foregoing provisional application, and a reference to "Thomas Prov" (hereinafter, "Thomas Provisional") in a citation shall refer to that portion of the specification of the foregoing provisional application where the subject matter being discussed is disclosed.

Since the filing date of Thomas is after the priority date of this application, Appellants submit that the portions of Thomas that are not disclosed in Thomas Provisional are not prior art to this application.

b. Clear error in rejection of independent claim 1

M.P.E.P. § 2142 states, *inter alia*, "The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that 'rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some

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rational underpinning to support the legal conclusion of obviousness.' *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR*, 550 U.S. at ___ , 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval)."

Appellants submit that the Examiner clearly erred in rejecting claim 1 because the Examiner's interpretation of Cooper with regard to claim 1 is erroneous, the combination of Thomas, Armstrong, and Cooper do not reasonably or logically lead to each and every limitation recited in claim 1, and the Examiner's reasoning with regard to claim 1 does not support the Examiner's legal conclusion of obviousness.

In the office action mailed on February 8, 2011, the Examiner stated, "However, neither Thomas nor Armstrong explicitly discloses that upon entering pause mode, the video replay system starts a timer, subsequently uses the timer to determine whether a delay greater than zero seconds has elapsed, and displays the first ad only after determining that the delay greater than zero seconds has elapsed." *See*, office action, page 5, section 9.

The Examiner then discussed Cooper. In particular, the Examiner stated, "Cooper discloses a method and system for delaying the display of a video output (see Cooper, at least C1, L64 – C2, L15). The disclosure of Cooper provides that a continuous analog or digital signal includes a reference signal that identifies an event (see Cooper, at least C3, L10-20, Fig. 2) that triggers a timer (see Cooper, at least C3, L20-65, Fig. 2), which timer counts down a period greater than zero seconds after which, a video output such as a color burst is displayed (see Cooper, at least C3, L40 – C4, L62, Fig. 2)." *See*, office action, page 5, section 10.

Although Cooper discloses identifying an event in a reference signal, such as the start of a color field I, or a unique event which repeats at a periodic rate of the reference signal but only once during each period, Appellants submit that Cooper does not disclose or suggest that the

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identified event comprises entering the pause mode. *See*, e.g., Cooper, column 3, lines 43-49, and column 6, lines 41-43. Accordingly, Appellants submit that Cooper does not disclose or suggest "upon entering the pause mode, the video replay system starting a timer."

With regard to a timer, Cooper discloses a programmable down counter circuit 8 that (i) receives a field one pulse 4 and a clock signal 5, and (ii) provides a reset output 12 and a delay steering signal output 14. *See*, Cooper, column 2, lines 32-35, and Figure 1. At the end of a delay period, the programmable down counter circuit 8 outputs the delayed reset pulse 12, which is used to reset a subcarrier generator 10 and a sync generator 9. *See*, Cooper, column 4, lines 28-31, and Figure 1. A composite sync from 9 and a color subcarrier from 10 are utilized by a black burst generator 11 to generate an industry standard black burst signal 13. *See*, Cooper, column 5, lines 43-46, and Figure 1. The reference from 13 is a delayed reference version thereof and may be coupled to the reference input of the video frame synchronizer, thereby providing an adjustable fixed or variable video delay, and via 14 a matching delay for one or more companion signals, all under control of the invention. *See*, Cooper, column 5, lines 53-59, and Figure 1.

Although the foregoing portions of Cooper disclose that counter circuit 8 receives a field one pulse 4 and a clock signal 5, Cooper does not disclose or suggest that receiving field one pulse 4 and/or clock signal 5 amount to entering the pause mode. Accordingly, even if, for the sake of argument, it is assumed that counter circuit 8 starts counting upon receiving field one pulse 4 and/or clock signal 5, Appellants again submit that Cooper does not disclose or suggest "upon entering the pause mode, the video replay system starting a timer."

Furthermore, as indicated above, the Examiner, in section 10 of the office action, stated the disclosure of Cooper provides for displaying a video output such as color burst. With regard

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to color burst, Cooper states, "The present invention will now be described by way of example with respect to its preferred embodiment as utilized with analog NTSC video signals which is made up of ***color burst***, horizontal syncs, defining horizontal lines, and vertical syncs defining fields. As is well known in the art, in video like and many other reference signals a sync component defines a negative period determined by a negative transition followed by a positive transition, and a positive period determined by a positive transition followed by a negative transition. It will be appreciated that these periods may be maintained in the delayed reference signal such that equipment to which it is coupled will recognize the delayed reference the same as it would recognize the input signal. As is well known in the art, the NTSC video signal has a period of 4 fields which fields are defined by the relative relationship of horizontal sync, vertical sync and ***color burst phase***." *See*, Cooper, column 2, lines 43-58, emphasis added.

Appellants submit that Cooper's disclosure pertaining to color burst does not include or suggest that the color burst phase is a video output or displaying the color burst phase of an NTSC video signal. Accordingly, Appellants submit that, contrary to the Examiner's statement in section 10 of the office action, Cooper does not provide for displaying a video output such as color burst. Furthermore, Appellants submit that Cooper does not disclose or suggest displaying an ad after the video replay system determines that the time delay has elapsed.

For at least the foregoing reasons, Appellants submit that Thomas, Armstrong, and Cooper do not reasonably or logically lead to ***upon entering the pause mode, the video replay system starting a timer*** and subsequently using the timer to determine whether a time delay greater than zero seconds has elapsed, and ***after the video replay system determines that the time delay has elapsed, displaying***, on the display of the video replay system, ***the first ad*** instead of the user selected program content, as recited in claim 1.

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Next, after discussing Cooper in section 10 of the office action, the Examiner stated, "It would have been obvious to one having ordinary skill in the art at the time of the invention to combine the method of displaying an ad on a video replay system disclosed in Thomas with the use of a pause key to pause user selected content, continued display of user-selected content during a delay following use of the pause key and display of a first ad following the delay as disclosed in Armstrong, and use of a digital timer to set a delay period prior to displaying video content as disclosed in Cooper. The predictable result of the combination would have been the ability to set the delay in a manner that would maximize views of the pause ads. One having ordinary skill in the art at the time of the invention would have had a reasonable probability of success in the combination." *See*, office action, pages 5-6, section 11.

Appellants submit that, based on the teachings of Thomas, which incorporates by reference the disclosure of Thomas Provisional, a person having ordinary skill in the art at the time of the invention would not have combined Thomas and Armstrong with Cooper to arrive at the invention recited in claim 1. In particular, Thomas-provisional teaches that pausing a real-time or recorded program causes the system to "freeze" the current picture, and that, for anyone viewing the media, the time the program is paused is useless or frustrating. *See*, Thomas Provisional, page 2, lines 3-6, (*See*, also, Thomas, paragraph 0005). Furthermore, Thomas Provisional teaches an alternative to freezing the current picture, because Thomas Provisional teaches, when a user pauses a real-time or recorded program, the media recording system presents pause-time content instead of a paused picture of the last frame. *See*, Thomas Provisional, page 2, lines 18-20, (*See*, also, Thomas, paragraph 0010).

Based on the foregoing portions of Thomas Provisional incorporated by reference into Thomas, Appellants submit that a person of ordinary skill in the art at the time of Appellants'

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invention would not have modified Thomas and Armstrong to use, as allegedly disclosed by Cooper, a digital timer to set a delay period prior to displaying video content. Indeed, modifying Thomas (or Thomas and Armstrong) with Cooper would actually render Thomas unsatisfactory for its intended purpose to avoid pausing a real-time or recorded program that causes the system to "freeze" the current picture, because anyone viewing the media, the time the program is paused is useless or frustrating.

Since the Examiner's interpretation of Cooper with regard to claim 1 is erroneous, and/or since the combination of Thomas, Armstrong, and Cooper do not reasonably or logically lead to each and every limitation recited in claim 1, and/or since the Examiner's reasoning with regard to claim 1 does not support the Examiner's legal conclusion of obviousness, Appellants submit that the Examiner clearly erred in rejecting claim 1. Therefore, Appellants submit that claim 1 is allowable and the rejection of claim 1 should be withdrawn.

c. Clear error in rejections of claims 2, 5-11, 13-15, 17, 18, 22, 24, 26, 27, and 31

Claims 2, 5-11, 13-15, 17, 18, 22, 24, 26, 27, and 31 each depend from claim 1. Appellants submit that those claims are allowable for at least the reason that they depend from allowable claim 1. Therefore, Appellants submit that the rejections of claims 2, 5-11, 13-15, 17, 18, 22, 24, 26, 27, and 31 should be withdrawn.

d. Clear error in rejection of claim 23

Claim 23 depends from claim 1. Appellants submit that claim 23 is allowable for at least the reason that it depends from allowable claim 1. Therefore, Appellants submit that the rejection of claim 23 should be withdrawn.

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e. Clear error in rejections of claims 25 and 28

Claims 25 and 28 each depend from claim 1. Appellants submit that those claims are allowable for at least the reason that they depend from allowable claim 1. Therefore, Appellants submit that the rejections of claims 25 and 28 should be withdrawn.

f. Conclusion

Applicant has demonstrated that the rejections of claims 1, 2, 5-11, 13-15, 17, 18, 22-28, and 31 are in error as a matter of law. Applicant therefore requests reversal of the rejections and allowance of the claims.

Respectfully submitted,

MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP

Date: May 9, 2011

By: /David L. Ciesielski/
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Claims Appendix

1. (Previously presented) A method of displaying an ad on a video replay system, the method comprising:

obtaining a first ad;

displaying, on a display of the video replay system, user selected program content stored at a storage medium of the video replay system;

while the user selected program content is being displayed on the display of the video replay system, entering a pause mode in response to a user action that comprises pressing a pause key;

upon entering the pause mode, the video replay system starting a timer and subsequently using the timer to determine whether a time delay greater than zero seconds has elapsed;

after starting the timer but prior to the video replay system determining that the time delay has elapsed, continuing to display the user selected program content on the display of the video replay system, wherein the user selected program content displayed during the time delay is paused; and

after the video replay system determines that the time delay has elapsed, displaying, on the display of the video replay system, the first ad instead of the user selected program content.

2. (Previously presented) The method of claim 1, further comprising:

allowing a user to set the time delay.

3-4. (Canceled)

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5. (Previously presented) The method of claim 1, wherein the first ad is a commercial ad.

6. (Previously presented) The method of claim 1, wherein the first ad is a user-selected picture.

7. (Previously presented) The method of claim 1, wherein the first ad is a user-selected still photograph.

8. (Previously presented) The method of claim 1, wherein the first ad is a user-selected video clip.

9. (Previously presented) The method of claim 1, wherein the first ad is a still commercial ad.

10. (Previously presented) The method of claim 1, wherein the first ad is a commercial ad containing a video clip.

11. (Previously presented) The method of claim 1, wherein the first ad is a video animation.

12. (Canceled)

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13. (Previously presented) The method of claim 1, wherein the first ad is obtained from an ad placement engine.

14. (Previously presented) The method of claim 1, wherein the first ad is obtained from external storage.

15. (Previously presented) The method of claim 1, wherein the first ad is downloaded from a computer connected to the video replay system.

16. (Canceled)

17. (Previously presented) The method of claim 1, wherein the first ad is a full-page ad.

18. (Previously presented) The method of claim 1, wherein the first ad occupies less than all of the display.

19-21. (Canceled)

22. (Previously presented) The method of claim 1, wherein the pause key is on the video replay system.

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23. (Previously presented) The method of claim 1, wherein the pause key is on the display of the video replay system.

24. (Previously presented) The method of claim 1, wherein the pause key is on a remote control.

25. (Previously presented) The method of claim 1, wherein the video replay system is a handheld video player.

26. (Previously presented) The method of claim 1,

wherein the user selected program content comprises a selected television program,

the method further comprising:

prior to displaying the user selected program content:

(i) receiving the selected television program content at the video replay system; and

(ii) storing the selected television program content at the storage medium of the video replay system

27. (Previously presented) The method of claim 1, wherein the display of the video replay system comprises a television set.

28. (Previously presented) The method of claim 1, wherein the display of the video replay system comprises a cellular device.

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29-30. (Canceled)

31. (Previously presented) The method of claim 1, further comprising:

the video replay system determining that the first ad has been displayed for a predetermined time period during the pause mode and the video replay system obtaining a second ad and causing the display of the video replay system to display the second ad instead of the first ad.

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Evidence Appendix

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Related proceedings appendix

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